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EXAMINER

LUONG, VINH

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UNITED STATES DEPARTMENT OF COMMERCE  
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 54

Serial Number: 08/629,547

Filing Date: April 9, 1996

Appellant: Satoshi KONO *et al.*

MAILED

MAY 22 2002

GROUP 3600

Richard L. Schwaab & Tod J. Burns for  
Appellants

**EXAMINER'S ANSWER**

This is in response to appellants' brief on appeal filed April 3, 2002.

(1) *Real Party in Interest.*

The statement of the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences.*

The statement of the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of claims.*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final.*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of invention.*

The summary of invention contained in the brief is correct.

*(6) Issues.*

The appellants' statement of the issues in the brief is correct.

*(7) Grouping of claims.*

The rejection of claims 113-165 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

*(8) Claims appealed.*

The copy of the appealed claims 113-165 contained in the Appendix to the brief is correct. Further, the examiner respectfully submits that claims 101-112 are allowed, thus, claims 101-112 should not be presented in the Appendix.

*(9) Prior Art of record.*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

*(10) New prior art.*

No new prior art has been applied in this examiner's answer.

*(11) Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 113-165 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. Please refer to the final rejection mailed on October 29, 2001(Paper No. 51).

*(12) New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

*(13) Response to argument.*

The examiner's response in Paper No. 51 is incorporated herein by reference. In the following, the examiner addresses the issues that have not been previously addressed.

**I. Background**

**A. The Law of Recapture**

The examiner does not dispute appellants' summary of recapture law.

**B. The Error Being Corrected Here Occurred in View of Older Claiming Rules for Claiming an Intangible Element.**

Appellants admitted that appellants' error was occurred in view of older claiming rules for claiming an intangible element. However, it is unclear as to how the instant error could be occurred when appellants knew or had the reason to know that appellants claim a flywheel assembly, *i.e.*, a tangible element.

**II. Does the Prosecution Record Clearly Demonstrate that Appellants Did Not Surrender the Flange 4b?**

**A. Is Surrender a Threshold Issue? Is Appellants' Statement "Where There Is No Broadening of Surrendered Subject Matter, There Can Be No Recapture" Correct?**

The examiner fully agrees that surrender is a threshold issue. Nevertheless, appellants' statement that if there is no broadening of surrendered subject matter, there can be no recapture is incorrect. It is well settled that appellants *cannot* acquire, through reissue, claims that are the *same* or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to

the rejection. Appellants' interpretation of the recapture rule fails to note the situation wherein the claims have the **same** surrendered subject matter that is germane to the prior art rejection.

**B. Whether Appellants' Statement "The Threshold Issue of Surrender Focuses on The Subject Matter That Has Been Eliminated From The Claims of the Original Patent" is Correct?**

Appellants' statement that the threshold issue of surrender focuses on the subject matter that has been eliminated from the claims of the original patent is likewise lacked proper legal foundation. As set forth above, in the case there is nothing eliminated from the claims of the original patent, if the reissue claims are the *same* or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection, it still can trigger the recapture.

**C. Is The Only Subject Matter Eliminated From the Reissue Claim The Flange b? Is The Limitation Added Substantially the Same as the Limitation Being Deleted?**

First, appellants' comparison of the final limitation (final paragraph) present in the '635 patent claim' and corresponding portions of reissue claims 113 and 128 in Exhibit C is not in compliance with the test set forth by the Court. The test is "whether the reissue claims are the *same* or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection." Hence, appellants should compare claims 16 and 18 of grand parent application Serial No. 07/485,659 (i.e., *not* the patent claim) with reissue claims 113 and 128, since claims 16 and 18 were rejected by the prior art Numata *et al.* (Japanese Patent Publication No. 57-058542) during the prosecution of SN'659.

Second, contrary to appellants' remarks, the flange b is *not* the only subject matter that is eliminated. The prosecution history of SN'659 shows that all of the subject matters in claims 16 and 18 of SN'659 have been eliminated.

Third, appellants contend that instead of using structure of the reinforcing element, appellants claim a first free space. However, the claimed first free space is narrower in another aspect unrelated to Numata rejection, consequently, the recapture rule is applied here.

**D. Does the Prosecution History Make Clear that Appellant Did Not Surrender Flange b?**

The prosecution makes clear that appellants did surrender the claimed subject matter in claims 16 and 18 of SN'659. Claims 16 and 18 call for a reinforcing member 4 that has the flange 4b. Claims 16 and 18 in turn were rejected by the Board decision on January 5, 1994. Appellants canceled claims 16 and 18 in SN'659 in order to obtain the issued Patent No. 5,465,635. Therefore, appellants surrendered the reinforcing member 4 which includes the flange 4b claimed in claims 16 and 18 of SN'659.

**III. Whether Appellants' Statement that "Even If The Reissue Claims are Considered, *Arguendo*, to Be Broadened With Respect to 'Surrendered Matter,' CCPA and CAFC Precedent Require a Finding of No Impermissible Reissue Recapture" is Correct?**

**A. Is Appellants' Statement "Recapture Is Avoided If the Reissue Claims Are Materially Narrowed in Other Respects" Correct?**

The recapture is not avoided if the reissue claims are materially narrowed in other respects that are unrelated to the prior art rejection as set forth by the Court. Appellants' statement above is partially incorrect since appellants do not define the *nexus* between the material respects and the prior art rejection in appellants' statement.

Second, appellants aver that the PTO's positions taken during the prosecution history of SN'659 and this application are inconsistent.

However, appellants fail to take into account the different bodies of law applied for the patentability of the original application and for the patentability of the reissued application. In SN'659, Numata does not teach or suggest the "wherein" clause of claim 1 of Patent No. 5,465,635. Meanwhile, in the reissue application, the test is not "whether the prior art teaches or suggests the claimed invention in the reissue claims." The recapture test in the reissue application is "whether appellants attempt to recapture what was surrendered to avoid the previous prior art rejection in the parent application." Applying this test, the subject matter of claims 16 and 18 of SN'659 are recited in claims 113 and 128 of this reissue application, thus, the appellants' claims 16 and 18 are not patentable since claims 113 and 128 recapture claims 16 and 18.

In summary, the PTO is consistent in the applications of different standards of patentability in regular patent application and reissue application as required by the Statute and the Court.

**B. Is Appellants' Statement "Even If the Materiality Must Relate to the Limitation Added During Prosecution, There is No Recapture in This Application" Correct?**

Appellants' statement is partially incorrect since if the materiality is related to the limitation added during the prosecution is unrelated to the prior art rejection, there is a recapture. The Court has laid this type of appellants' arguments to rest in *Pannu v. Storz Instruments Inc.*, 59 U.S.P.Q.2d 1597 (CAFC 2001). This case is similar to *Pannu* wherein appellants canceled claims 16 and 18 in SN'659, and filed the reissue application to copy back claims 16 and 18 in reissue claims 113 and 128.

**C. Are The Facts of The Present Case “On All Fours” With Those of Richman?**

Appellants contend that the case law has consistently permitted a reissue applicant to remove part of a limitation added by the amendment during prosecution of the original patent, where the partial limitation removed *was clearly not necessary* to establish patentability. However, in the instant case, the partial limitation removed *was clearly necessary* to establish patentability. Indeed, without the adding of the “wherein” clause in claim 1 of Patent No. 5,465,635, the examiner would maintain the rejections made by the Board based on Numata.

**D. Is a Finding of No Recapture in This Case Consistent with the Totality of CAFC or CCPA Precedent?**

Appellants’ cited case law actually supports the recapture rejection because the totality of the instant case shows that appellant attempts to recapture claims 16 and 18 of SN’659 in claims 113 and 128 of this application as evidenced by the fact that appellant copied or incorporated claims 16 and 18 in claims 113 and 128. On the other hand, the instant case is similar to Example 4(a) of the PTO Memorandum “Applying the Recapture Rule to Reissue Applications” (appellant’s Exhibit D).

**CONCLUSION**

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,

Vinh T. Luong  
Primary Examiner

Conferees on May 14, 2002:

Supervisory Patent Examiner David Bucci and  
Primary Examiner Lennard Footland.